

Application No.: 09/586,641  
Amendment dated March 16, 2004  
Reply to Office Action of January 9, 2004

## **REMARKS/ARGUMENTS**

### **Status Of Application**

Claims 1-20 are pending in the application; the status of the claims is as follows:

Claims 11-15 are rejected under 35 U.S.C. § 101 as the claimed invention is directed to non-statutory subject matter.

Claims 1-3, 6-8, 11-13, and 16-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,552,813 B2 to Yacoub ("Yacoub").

Claims 4, 9, 14, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of Japanese Published Application No. (A) 10-301737 to Hirofumi Nishiwaki et al ("Hirofumi").

Claims 5, 10, 15, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of U.S. Patent No. 6,424,425 B1 to Otsuka ("Otsuka").

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicant respectfully requests receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

**Claim Amendments**

Claims 11-15 have been amended from a “computer program product” to a “computer readable medium including computer executable code capable of being run on a computer” to overcome a 35 U.S.C. § 101 rejection. These changes do not introduce any new matter.

Claims 2, 3, 7, 8, 17, and 18 have been amended to correct a repeated grammatical error. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

**35 U.S.C. § 101 Rejection**

The rejection of claims 11-15 under 35 U.S.C. § 101 as the claimed invention is directed to non-statutory subject matter, is respectfully traversed based on the following.

Independent claim 11 has been amended to from a “computer program product” to a “computer readable medium including computer executable code capable of being run on a computer” to overcome a rejection based upon the Computer-Implemented Invention Guidelines. The Applicant believes the invention of amended claim 11 is therefore no longer a computer program *per se*. Claims 12-15 depend from independent claim 11 and have been similarly amended.

Accordingly, it is respectfully requested that the rejection of claims 11-15 under 35 U.S.C. § 101 as the claimed invention is directed to non-statutory subject matter, be reconsidered and withdrawn.

**35 U.S.C. § 102(e) Rejection**

The rejection of claims 1-3, 6-8, 11-13, and 16-18 under 35 U.S.C. § 102(e) as being anticipated by Yacoub, is respectfully traversed based on the following.

Claim 1 includes a substitution controller that corrects print data “to ensure that quality of the images printed by the selected substitute printer is the same as that of the images printed by the printer in which the problem is detected, and for outputting the corrected print data to the selected substitute printer.” In other words, the substitution controller ensures that the print quality from the substituted printer is the same as the print quality from the original printer. By way of example, and not limitation, page 9, line 19 through page 10, line 2 describes ensuring print quality for different color printers. Differences in print quality may be due to differences in the printer manufacturers, models, and output methods. To counteract these differences in print quality, the controller corrects print data, i.e., the print data itself is modified. [As a simple equivalent example, the Examiner has likely been to an appliance store selling televisions. While each of 20 televisions may be showing the same program, each appears quite different in terms of contrast, brightness, hue, etc. The television equivalent of the current application would correct these image quality differences such that the image quality on each television would be identical.]

Yacoub, in contrast, does not disclose correcting print data to ensure the same print quality regardless of which substitute printer is selected. Yacoub merely selects a substitute printer capable of the print quality options (such as color or black and white) selected by the user. At no time does Yacoub disclose or suggest correcting the print data itself to ensure consistent print quality. Because Yacoub does not disclose or suggest correcting the actual print data sent to a substitute printer, Yacoub fails to anticipate claim 1.

Claims 2 and 3 depend from unanticipated claim 1 and are unanticipated for at least the same reasons. Furthermore, claims 2 and 3 provide additional limitations not found in Yacoub. With respect to claim 2, the Office Action fails to provide any indication as to what portion of Yacoub discloses or suggests a substitution controller that “performs correction so that a color characteristic of the color image printed by the printer in which the problem is detected is the same as that of the color image printed by the

selected substitute printer.” This is because Yacoub does not disclose or suggest a substitution controller capable of modifying print data to ensure a uniform color characteristic regardless of the printer used. Thus, Yacoub does not disclose or suggest a limitation of claim 2 and therefore cannot anticipate claim 2 for this additional reason. Claim 3 similarly includes a limitation on how print data is to be modified that is not disclosed or suggested by Yacoub. Because Yacoub does not disclose or suggest modifying middletone print data depending upon use of a substitute printer, Yacoub cannot anticipate claim 3 for at least this additional reason.

Claim 6 is a method claim that requires correcting print data to ensure image quality regardless of printer. As discussed above, Yacoub does not disclose or suggest correcting print data and therefore cannot anticipate claim 6. Claims 7 and 8 depend from claim 6 and have similar limitations to claims 2 and 3. As Yacoub does not disclose or suggest correcting data as required by claims 7 and 8, Yacoub cannot anticipate claims 7 and 8.

Claims 11-13 generally correspond to claims 1-3, respectively, and, as shown above, Yacoub neither discloses nor suggests these limitations regarding correcting print data. For these reasons, Yacoub cannot anticipate claims 11-13.

Claims 16-18 generally correspond to claims 1-3, respectively, and, as shown above, Yacoub neither discloses nor suggests these limitations regarding correcting print data. For these reasons, Yacoub cannot anticipate claims 16-18.

Accordingly, it is respectfully requested that the rejection of claims 1-3, 6-8, 11-13, and 16-18 under 35 U.S.C. § 102(e) as being anticipated by Yacoub, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejections**

The rejection of claims 4, 9, 14, and 19 under 35 U.S.C. § 103(a), as being unpatentable over Yacoub as applied to claim 1 above, and in view of Hirofumi, is respectfully traversed based on the following.

As noted above, Yacoub fails to disclose or suggest correcting print data, a limitation of claim 1 from which claim 4 depends. Hirofumi, like Yacoub, fails to disclose or suggest correcting print data, but rather is directed to detecting printer errors and sending print data to a substitute printer. As the combination of Yacoub and Hirofumi fails to disclose or suggest correcting print data, the combination of Yacoub and Hirofumi cannot render obvious the invention of claim 1. As claim 4 depends from nonobvious claim 1, claim 4 is nonobvious for at least the same reasons.

The combination of Yacoub and Hirofumi similarly fails to render obvious claims 6, 11, and 16 by not disclosing or suggesting correcting print data as required by these claims. Therefore claims 6, 11, and 16 are nonobvious, and claims 9, 14, and 19 are nonobvious for at least the same reasons due to their dependence upon claims 6, 11, and 16, respectively.

Accordingly, it is respectfully requested that the rejection of claims 4, 9, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of Hirofumi, be reconsidered and withdrawn.

The rejection of claims 5, 10, 15, and 20 under 35 U.S.C. § 103(a), as being unpatentable over Yacoub as applied to claim 1 above, and in view of Otsuka, is respectfully traversed based on the following.

As noted above, Yacoub fails to disclose or suggest correcting print data, a limitation of claim 1 from which claim 5 depends. Otsuka, like Yacoub, fails to disclose or suggest correcting print data. Otsuka is directed to reading and transmitting facsimile

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images, not correcting print data to ensure uniform print quality. As the combination of Yacoub and Otsuka fails to disclose or suggest correcting print data, the combination of Yacoub and Otsuka cannot render obvious the invention of claim 1. As claim 5 depends from nonobvious claim 1, claim 5 is nonobvious for at least the same reasons.

The combination of Yacoub and Otsuka similarly fails to render obvious claims 6, 11, and 16 by not disclosing or suggesting correcting print data as required by these claims. Therefore claims 6, 11, and 16 are nonobvious, and claims 10, 15, and 20 are nonobvious for at least the same reasons due to their dependence upon claims 6, 11, and 16, respectively.

Accordingly, it is respectfully requested that the rejection of claims 5, 10, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of Otsuka, be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

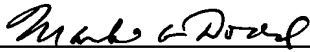
This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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